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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,630	10/29/2003	Charles Mizrahi	11687/3	7338

7590 12/29/2006  
KENYON & KENYON  
One Broadway  
New York, NY 10004

EXAMINER
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STAIKOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/697,630

Applicant(s)

MIZRAHI ET AL.

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/29/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/29/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicants' amendment filed October 29, 2004 has been entered. Claims 15-29 are pending in the instant application.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 15-19, 21-23, 24-25 and 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiraoka *et al.* (US Patent No. 6,255,235 B1).

Regarding claim 15, Hiraoka *et al.* ('235) teach the claimed process for making a sole for footwear (see col. 1, lines 7-9) including, providing a mold (11), positioning a rubber preform

(R) over said mold (11), forming said rubber preform (R) into an inner sole, placing a fabric preform (16) over said inner sole, compressing under heat and pressure said fabric preform (16) and said inner sole such that said rubber of inner sole melts and partially impregnates to unite against said fabric preform (16) and form said sole for footwear (see col. 6, line 23 through col., 7, line 21 and Figures 2(a)-2(e)).

In regard to claims 16-17, Hiraoka *et al.* ('235) teach a rubber (thermoplastic) preform (R) including a thermoplastic material (see col. 3, lines 18-30 and col. 4, lines 17-25).

Specifically regarding claim 18, Hiraoka *et al.* ('235) teach compressing under heat and pressure said fabric preform (16) and said inner sole such that said rubber of inner sole melts and partially impregnates to unite against said fabric preform (16) and form said sole for footwear (see col. 6, line 23 through col., 7, line 21 and Figures 2(a)-2(e)).

Regarding claim 19, Hiraoka *et al.* ('235) teach placing said fabric preform inside a mold cavity over the rubber preform (R) (see Figure 2(d)-2(e)), hence it is submitted that because both the fabric and the rubber preforms are placed in the same mold cavity, that the fabric preform is conformed to the rubber preform.

In regard to claims 21 and 23, Hiraoka *et al.* ('235) teach a first step of positioning a rubber preform in said mold (delivering step) to form said inner sole and a second step of positioning said fabric preform over said formed inner sole see col. 6, line 23 through col., 7, line 21 and Figures 2(a)-2(e)).

Specifically regarding claim 22, Hiraoka *et al.* ('235) teach another embodiment where in a first step, said fabric is positioned in said mold and then, in a second step, a rubber preform is

applied over said fabric preform (see col. 8, line 37 through col. 9, line 10 and, Figures 7(a)-7(c) and 8(a)-8(c)).

Regarding claims 24 and 27, Hiraoka *et al.* ('235) teach a process for making an outer sole including, forming portions where said fabric is partially impregnated with rubber and portions where said fabric is not impregnated with rubber (see Figure 8(c)). Further, Hiraoka *et al.* ('235) teach forming an outer sole having portions where said fabric is partially impregnated with rubber and said inner sole is exposed to the outer surface and a portion where said fabric is exposed to the outer surface (see Figure 9(d)).

In regard to claims 25 and 28, Hiraoka *et al.* ('235) teaches a rubber and a polyurethane (thermoplastic) material (see col. 1, line 32; col. 3, lines 18-30; col. 4, lines 17-25).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otis (US Patent No. 6,430,844 B1) in view of Hiraoka *et al.* (US Patent No. 6,255,235 B1).

Otis ('844) teaches the basic claimed process for making an outsole for a shoe including an external fabric layer that is molded in situ to an inner rubber or plastic sole (see col. 2, lines 34-40).

Regarding claim 15, although Otis ('844) teaches in situ molding, Otis ('844) does not specifically teach partial impregnation of the fabric by the rubber or plastic material. Hiraoka *et al.* ('235) teach a process for making a sole for footwear (see col. 1, lines 7-9) including, providing a mold (11), positioning a rubber preform (R) over said mold (11), forming said rubber preform (R) into an inner sole, placing a fabric preform (16) over said inner sole, compressing under heat and pressure said fabric preform (16) and said inner sole such that said rubber of inner sole melts and partially impregnates to unite against said fabric preform (16) and form said sole for footwear (see col. 6, line 23 through col., 7, line 21 and Figures 2(a)-2(e)). Therefore, it would have been obvious for one of ordinary skill in the art to use the compression molding steps of Hiraoka *et al.* ('235) to make the outsole in the process of Otis ('844) because Hiraoka *et al.* ('235) teaches an efficient and reliable process for making a shoe outsole and also because, Otis ('844) specifically teaches in situ molding, hence suggesting the compression molding process of Hiraoka *et al.* ('235).

In regard to claims 16-17, Otis ('844) teaches a rubber or a plastic substrate (see col. 2, lines 34-40). It is noted that because the plastic substrate of Otis ('844) includes tread marks (see col. 2, lines 41-43) and the molding occurs in situ, it is submitted that the plastic substrate is a thermoplastic material.

Specifically regarding claim 18, Hiraoka *et al.* ('235) teach compressing under heat and pressure said fabric preform (16) and said inner sole such that said rubber of inner sole melts and partially impregnates to unite against said fabric preform (16) and form said sole for footwear (see col. 6, line 23 through col., 7, line 21 and Figures 2(a)-2(e)). Therefore, it would have been

obvious for one of ordinary skill in the art to use the compression molding steps of Hiraoka *et al.* ('235) to make the outsole in the process of Otis ('844) because Hiraoka *et al.* ('235) teaches an efficient and reliable process for making a shoe outsole and also because, Otis ('844) specifically teaches in situ molding, hence suggesting the compression molding process of Hiraoka *et al.* ('235).

Regarding claim 19, Hiraoka *et al.* ('235) teach placing said fabric preform inside a mold cavity over the rubber preform (R) (see Figure 2(d)-2(e)), hence it is submitted that because both the fabric and the rubber preforms are placed in the same mold cavity, that the fabric preform is conformed to the rubber preform. Therefore, it would have been obvious for one of ordinary skill in the art to use the compression molding steps of Hiraoka *et al.* ('235) to make the outsole in the process of Otis ('844) because Hiraoka *et al.* ('235) teaches an efficient and reliable process for making a shoe outsole and also because, Otis ('844) specifically teaches in situ molding, hence suggesting the compression molding process of Hiraoka *et al.* ('235).

In regard to claim 20, although Otis ('844) in view of Hiraoka *et al.* ('235) do not teach trimming of excess fabric material, trimming is well known. Therefore, it would have been obvious for one of ordinary skill in the art to trim excess fabric in the process of Otis ('844) in view of Hiraoka *et al.* ('235) because of known advantages that trimming provides such as improved aesthetics, hence providing for an improved product.

Specifically regarding claims 21 and 23, Hiraoka *et al.* ('235) teach a first step of positioning a rubber preform in said mold (delivering step) to form said inner sole and a second step of positioning said fabric preform over said formed inner sole see col. 6, line 23 through

col., 7, line 21 and Figures 2(a)-2(e)). Therefore, it would have been obvious for one of ordinary skill in the art to use the compression molding steps of Hiraoka *et al.* ('235) to make the outsole in the process of Otis ('844) because Hiraoka *et al.* ('235) teaches an efficient and reliable process for making a shoe outsole and also because, Otis ('844) specifically teaches in situ molding, hence suggesting the compression molding process of Hiraoka *et al.* ('235).

Regarding claim 22, although Otis ('844) in view of Hiraoka *et al.* ('235) do not teach placing the fabric in said mold prior to the rubber preform, it is submitted that whether the fabric is placed in the mold before or after the rubber preform does not appear to provide unexpected results and as such is a mere choice of performing processing steps in a certain order. It would have been obvious for one of ordinary skill in the art to place the fabric in the mold prior to the rubber preform in the process of Otis ('844) in view of Hiraoka *et al.* ('235) because of a variety of unclaimed factors such as handleability, ease of operation, programming of the operation line, etc. and also because whether the fabric is placed in the mold before or after the rubber preform does not appear to provide unexpected results and as such is a mere choice of performing processing steps in a certain order.

6. Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiraoka *et al.* (US Patent No. 6,255,235 B1) in view of Bateman (US Patent No. 3,520,765).

Hiraoka *et al.* ('235) teach the basic claimed process as described above.

Regarding claims 26 and 29, although Hiraoka *et al.* ('235) teach a woven fabric, Hiraoka *et al.* ('235) do not teach that said woven fabric is made from a blend of fibers. However, the use of fiber blends in making shoe components is well known as evidenced by Bateman ('765) who



teaches a woven fabric of a blend of synthetic and cotton fibers used in making shoe components (see col. 2, lines 22-24). Therefore, it would have been obvious for one of ordinary skill in the art to provide a woven fabric of a blend of synthetic and cotton fibers as taught by Bateman ('765) as the fabric layer in the process of Hiraoka *et al.* ('235) because Bateman ('765) teaches that such a fabric provides for improved resistance to rupture, good wear resistance and its relatively economical to produce, hence providing for an improved product and also because both references teach shoe components having a fabric layer, hence suggesting the use of the fabric of Bateman ('765) in the process of Hiraoka *et al.* ('235).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD

A handwritten signature in black ink, appearing to read 'Stefan Staicovici', written in a cursive style.

Primary Examiner

12/21/06

AU 1732

December 21, 2006